

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-4 and 6-14 are pending in the application, with claims 1 and 9 being the independent claims. Claims 9-14 were previously withdrawn. Claim 5 is sought to be cancelled without prejudice to or disclaimer of the subject matter therein.

Claim 1 has been amended. Support for the amendment to claim 1 can be found throughout the application as filed, e.g., in previously presented claim 5. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Miscellaneous Matters

Applicants thank the Examiner for reconsidering the Office Action of the July 17, 2008 Office Action in view of the Applicants' Pre-Appeal Brief Request, and for the withdrawal of the previous claim rejections under 35 U.S.C §§ 102 and 103.

Rejection of claims 1-7 under 35 U.S.C. § 102(a)

Claims 1-7 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Jeong et al., (*Bioconjugate Chemistry* 14:473-479 (2003)) ("Jeong"), published on-line on March 5, 2003.

Provided herewith is a Declaration Under 37 C.F.R. § 1.132 by Ji Hoon Jeong and Tae Gwan Park, inventors of the captioned application. In paragraph 4 of the Declaration, the inventors declare that they conceived, designed and carried out experiments as described in the Jeong article. The inventors also declare that they conceived of the claimed invention. In paragraph 5 of the Declaration, the inventors declare that Sung Wan Kim carried out the experiments of the Jeong article *under the direction and control of the inventors of the captioned application*. Applicants respectfully assert that the use of Jeong as a reference under 35 U.S.C. § 102(a) is not proper, because Jeong is Applicants' disclosure of their own work. See 37 C.F.R. § 1.132, as well as MPEP 716.10, which states that a rejection under 35 U.S.C. § 102(a) may be overcome by establishing that the portions of the reference pertinent to the claimed invention describe Applicants' own work.

For at least the above reason, Applicants respectfully request that the rejection of claims 1-7 under 35 U.S.C. § 102(a) be withdrawn.

Rejection of Claims 1-7 under 35 U.S.C. § 103(a)

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Tullis (U.S. Pat. No. 4,904,582) and Goodchild (*Bioconj. Chem.* 1:165-187 (1990)). Specifically, the Examiner alleged that Tullis described oligonucleotide conjugates for transport across cellular membranes for modulating gene expression. The Examiner alleged that Goodchild describes that conjugate groups such as PEG can be covalently linked to oligonucleotides by hydrozone formation. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, the art cited by the Examiner must (1) teach or suggest all of the claim limitations; (2) provide a suggestion or motivation to those of ordinary skill in the art to make the claimed composition; and (3) reveal that one of ordinary skill would have a reasonable expectation of success in doing so. *See In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The United States Supreme Court, in *KSR International vs. Teleflex, Inc.*, 550 U.S. 398, (2007), further clarified the requirements for obviousness analysis under 35 U.S.C. § 103(a). The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made *explicit*, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. KSR did not remove the legally established requirement that each element of each claim must be taught in the documents cited by the Examiner.

Claim 1 is an independent claim. Claim 4 has been cancelled. Claims 2 and 5-7 depend from claim 1. Solely to advance prosecution of the application, claim 1 has been amended to recite an "acid-cleavable linkage *selected from the group consisting of phosphoroamidate linkage and acetal bond.*" Neither Goodchild nor Tullis describe or suggest an acid-cleavable linkage selected from the group consisting of phosphoroamidate linkage and acetal bond. Thus, these claims are not obvious in view of the cited documents. Applicants respectfully request that the rejection of claims 1-7 under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claim 8 under 35 U.S.C. § 103

Claim 8 was rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Tullis and Goodchild in further view of Bennett *et al.* (*J. Clin. Invest.* 93:820-828 (1994)). Applicants respectfully traverse this rejection.

Claim 8 is dependent on claim 1. As described above, claim 1 recites an "acid-cleavable linkage *selected from the group consisting of phosphoroamidate linkage and acetal bond*," and that neither Goodchild nor Tullis teach or suggest such a bond. Bennett does not cure the deficiencies of Goodchild and Tullis, and thus each and every element of claim 1 (and claim 8) is not taught or suggested even by a combination of the cited documents. In view of the above, Applicants respectfully request that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Amdt. dated Aug. 26, 2009
Reply to Office Action of May 26, 2009

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Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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